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Supreme Court of the United States

OCTOBER TERM, 1941

No. ~~1130~~ 71

UNITED CARBON COMPANY and
UNITED CARBON COMPANY, INC.,

Petitioners,

vs.

BINNEY & SMITH COMPANY,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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No. 1130

UNITED CARBON COMPANY and
UNITED CARBON COMPANY, INC.,

Petitioners,

vs.

BINNEY & SMITH COMPANY,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondent is opposed to the grant of *certiorari* in this suit and submits the following statement of reasons why the writ should not be granted:

1. No conflict exists between the decision of the Court below and that of any other Court. The Court below did not pass on any contested issue of law and the issues of fact which it decided have not appeared in any other suit.

The Court below considered and discussed briefly the question of whether, assuming the patented product to be new and that its production involved an act of invention, that product is of such a nature that it may be made the

subject of patent protection (R. p. 486-7). Petitioners had never contended that such a product, if new and inventive, is not patentable, and it presents no such contention in the petition and brief.

On the only other issue of law entering into its decision, the Court below said the "rule is well settled" (R. p. 490) and proceeded to state a rule which has never been the subject of contest in this suit.

The contested issues which the Court below *did* decide are issues of *fact*. Those issues relate to the novelty of the patented product, the presence of an act of invention in the production of the patented product, the identity of Petitioners' product with that described and claimed in the patent, and the relation of the claims in suit to claims which were presented and withdrawn in the course of the prosecution of the application for the patent. As to those issues of fact, there is not and could not be any conflict of decision because this suit is the first in which those issues have been presented and the only one in which a Court has ruled on them.

2. Conflict of decision on the issues of fact decided by the lower Court may arise at some later date. Suits are now pending in which those issues are presented. There are two such suits, one pending in the First Circuit and one pending in the Third Circuit.* If in either of those suits the Court of Appeals reaches a conclusion contrary to that of the Court of Appeals in this case, then a conflict will exist which may warrant the grant of *certiorari*. On

* The suits referred to are:
1. *Binney & Smith Company* v. *Godfrey L. Cabot, Inc. and Cabot Carbon Company*, Eastern District of Massachusetts, Civil Action No. 1782; and
2. *Godfrey L. Cabot, Inc.* v. *Binney & Smith Company*, District of New Jersey, Civil Action No. 1978.

the other hand, if those other Courts of Appeals concur in the decision of the Court of Appeals in this case, there may be no occasion for the grant of *certiorari* then, just as there is none now.

3. Of the questions stated by Petitioners as "Questions Presented" in this case (Petition, p. 9-10), those numbered 1 and 2 are not presented at all. Each of those questions is "does a prior patent which describes a product" suffice for a stated purpose. No such question is presented by the record and no such question was decided by the lower Court.

The decision of the lower Court is that each of the prior patents referred to by Petitioners does *not* describe the product under consideration in this case. That is stated repeatedly in the opinion.

The lower Court described the products of the prior patents to show wherein they differ from the patented product (R. p. 484, l. 5-9; 488-9; and 495, l. 6-15). Then, by way of summary as to all of the prior patents, the Court said "None of these patents discloses any such product as is covered by the patent sued on" (R. p. 488).* Also, the Court said the product of the patent in suit was "an entirely new form of a product" and "a new and highly useful product" (R. p. 487).

There is no conflict between the decision of the lower Court in this case and the decision of this Court in *Cohn* v. *United States Corset Co.*, 93 U. S. 366, nor did the lower Court either misapply or disregard this Court's decision in that case. In the *Cohn* case, the patent in suit covered an article and this Court held the patent invalid on evi-

* In connection with the Knowlton & Hoffman patent, the Supplemental Opinion of the Court on the Petition for Rehearing should be noted (R. p. 494-5).

dence that the patented article was not new. In its opinion, this Court said, as stated by Petitioners (p. 5), that it is

> "immaterial that a prior patent set up as an anticipation of an article claim of a later patent is insufficient to teach a manufacturer how to make"

the article, and that the prior patent is sufficient as an anticipation if it describes the patented article. That has no application here where the lower Court specifically held, and stated time and again, that the patent in suit describes and claims "an entirely new form of a product" and that the products of the prior patents were entirely different from the patented product both in physical form and in utility. Therefore, the asserted conflict with the *Cohn* case and the cases cited in connection therewith (Petition, p. 5, 10, 18 and 20) does not exist. Furthermore, if the elementary principle stated in the above quotation from the *Cohn* case is the "principle of law enunciated by this Court in the *Cohn* case" referred to by Petitioners on page 20 and the "federal question" referred to at various other points (p. 10, 16), it does not need to be "freed from doubt" because it is already in that condition and none the less so because of the decision of the Court below.

4. The third of the "Questions Presented" is not presented in this case in any sense other than that in which the question may be said to be presented in every patent suit wherein the issue of validity is decided. In any such suit, one side or the other may assert that the lower Court misunderstood, misinterpreted and misapplied the principles governing decision of that issue of fact.

In this case, the lower Court set forth at some length the basis for its decision, particularly in the paragraph beginning in the middle of page 487 of the record. The

items there stated as having an important bearing upon the fact issue of the presence or absence of patentable invention are items which have been stated repeatedly by this Court to be items of great importance and items which the lower Courts have considered and have stated quite generally that they considered in conformity with the decisions of this Court. A typical instance is the decision of the Court of Appeals of the Second Circuit in *Buono* v. *Yankee Maid Dress Corporation*, 77 F. (2d), 274, where the pertinent comment of that Court (p. 276-7) is followed by citation of many decisions of this and other Courts supporting the view expressed. The decisions of this Court there cited* are authorities supporting the decision of the lower Court set forth in the paragraph of the opinion on pages 487 and 488 of the record.

5. The questions numbered 4 and 5 of the "Questions Presented" (Petition, p. 10) are not questions of law as to which there is any conflict or asserted conflict or any occasion for further comment and decision by this Court. As to the legal principle involved, the statement of the lower Court is that:

> "The rule is well settled, of course, that claims allowed may not be construed so as to cover broader claims which have been rejected and abandoned" (R. p. 490).

On this branch of the case, the only question which is or could be presented is a question of fact involving the application of the "well settled" rule to the incidents of this case.

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* *Paramount Publix Corp.* v. *American Tri-Ergon Corporation*, 294 U. S. 464, 474; *Hobbs* v. *Beach*, 180 U. S. 383, 392, 393; *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403, 429, 430; *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381.

It is true that certain claims presented by the applicants for the patent in suit were allowed and certain others were rejected, and some of the rejected claims were cancelled. This is a common condition in the prosecution of applications for patents. In this case the lower Court examined the proceedings in the Patent Office leading up to the grant of the patent in suit and found there nothing whatever which borders on recapture of subject matter which had been claimed and was later acknowledged to be unpatentable by cancellation of a claim. Petitioners contended otherwise and that contention presented a specific issue of fact for decision, the rule applicable in determining that issue of fact being "well settled."

6. Petitioners' further point—and on this Petitioners are more repetitious than elsewhere—deals with the use of the patented product rather than with its physical properties, with what it *does,* not what it *is.*

This further point includes the suggestion that preparations for the national defense and offense may be restricted or disturbed by action of the Courts in litigation of the patent in suit in the form of injunctions restraining manufacture of the patented carbon-black product needed in rubber manufacture.

This suggestion assumes that the patent owner is unwilling to grant manufacturing rights under the patent, and that those now operating as licensees under the patent are unable to supply the product in adequate volume. The record evidence is that the patent owner has already granted manufacturing rights under the patent and is ready and willing to grant such manufacturing rights to others at any time (R. p. 48 and 63-4). One of its licensees is producing the patented product in very considerable volume (R. p. 37).

Petitioners' suggestion also assumes that the Federal Courts of the United States will be willing to grant injunctions in suits for patent infringement restraining defendants from proceeding with manufacture of articles for which there is an immediate need in the prosecution of the war, and that patent owners will solicit the Courts to issue injunctions restraining such manufacture. We do not concur in either of these suggestions.

7. It is true, as stated by Petitioners (p. 15) that this Court has granted writs of *certiorari* in cases not presenting conflict of decision in the lower Courts but presenting circumstances considered by this Court to make it desirable that some lower Court decision be reviewed, and the cases listed on page 15 of Petitioners' brief are typical instances. Those cases did present "exceptional circumstances peculiarly affecting the public." Three of them are cases in which it appeared that the patent in suit would never be litigated in any Circuit other than that of the decision to be reviewed. No such "exceptional circumstances" appear in this case and litigations are now pending in two other Circuits, either of which could result in a conflict of decision of Courts of Appeals which would call for the grant of *certiorari*.

Respectfully submitted,

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Dated: New York, N. Y.,
May 1, 1942.